

### **REMARKS**

The Specification has been voluntarily amended to track the language proposed by the Examiner. The Specification is being amended without prejudice.

Original claims 1-17 and new claims 18-27 are pending. All of original claims 1-17 have been rejected as obvious in view of Greanias et al (U.S. Pat. No. 5,007,085) in view of Inoue et al (U.S. Pat. No 5,831,600) and in further view of Ohara et al (U.S. Pat. No. 6,297,812 B1). New claims 18-27 have not yet been examined. The rejections of claims 1-17 are traversed for the following reasons.

#### **The Primary Reference, Greanias, is Mischaracterized**

The Examiner has relied upon Greanias as the primary reference. The Examiner states “Figs. 1-8 of Greanias, et al broadly discloses the interactive book system and method comprising a radio frequency (R) scanning circuit . . . configured to detect the presence of a coordinate input device (such as stylus) enters the RF field generated by the RF scanning circuit . . .” The Examiner characterizes the invention of Greanias as a book system and the stylus as essentially an optional form of coordinate input device (“such as stylus”). To the contrary, the invention of Greanias is, quite specifically, the stylus.

The Greanias patent is entitled “Remotely Sensed Personal Stylus”. There are five objects of the invention (col. 2, lines 24-40) and all refers specifically to an interactive stylus. So does each descriptive paragraph constituting the substantive remainder of the Summary of the Invention claim portion of the Greanias (col. 2, line 46 – col. 3, line 12). Each independent (1, 13, 23, and 32) is directed to a remotely sensed personal stylus (claim 23) or a system specifically utilizing such a stylus (1 and 13) or a method of controlling access to a computer specification using such a stylus (claim 32). The stylus is the invention of Greanias rather than merely an optional element of an invention.

#### **The combination of Greanias with Inoue is Unsupported**

In support of the rejection, the Examiner argues:

It is noted that the teaching of Greanias et al does not specifically disclose the human finger (as per claims 1 and 14) as required. However, the teaching of Inoue et al broadly discloses that such feature of the coordinate input device (2) such as stylus (2-1, 52) or . . . human finger (2-2, 52) are obvious and

consider(ed) an obvious design choice, so as to select the design(at)ed area of interest for generating the corresponding information.

Regardless of the teaching of Inoue, the substitution of a finger or the stylus of Inoue for the stylus disclosed and claimed in Greanias is unsupported.

A *prima facie* case of obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1598 (Fed. Cir. 1988); MPEP §2143.01.

The fact that references can be combined or modified is not sufficient for *prima facie* obviousness. MPEP §2143.01.

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. MPEP §2143.01

Further, the proposed modification cannot change the principle operation of a reference. MPEP §2143.01 The Examiner's proposed substitution of a finger changes the principle of operation of the primary reference, Greanias. Furthermore, the stylus of Greanias is interactive. The stylus and finger of Inoue are not or at least are not in the same way of receiving position signals and transmitting back to the computer, an identification code with an amplitude value so the computer can calculate the position of the stylus on the display. The third reference, Ohara, does not teach or suggest anything which would lend support to the combination of Greanias with Inoue as proposed by the Examiner.

**The Rejections of Dependent Claim 2 and Claims 3-12 Depending Therefrom Are Further Unsupported For the Following Additional Reason**

Claim 2 depends from Independent Claim 1 and further calls for the scanning circuit to comprise a matrix of conductive lines arranged as spaced apart columns and spaced apart rows:

....wherein for each specific column conductive line:

(i) an RF signal is input into the specific column conductive line according to a predetermined input sequence as directed by a first coordinated control signal (655) outputted by the control circuit (610), and

(ii) coupled RF signals received from the specific column conductive line by the plurality of row conductive lines are outputted according to a predetermined

output sequence as directed by a second coordinated control signal (660)  
outputted by the control circuit (610).

Greanias describes several different embodiments. In each, the column and row conductors are each powered in some sequence to transmit 40 kHz signal bursts which the stylus attempts to receive. Only the last embodiment of Greanias, which is depicted in and described with respect to Fig. 6, involves using the matrix array conductors as receiving antennae. The other embodiments use an IR transmitter in the stylus and an IR receiver in the work station with which the stylus is used. (See col. 4, lines 41-63.). Only the Fig. 6 embodiment of Greanias can be said to be “configured to detect the presence of a coordinate input device (such as a stylus) [as it] enters the RF field generated by the RF scanning circuit” as asserted by the Examiner. However, a review of that figure and the description of its operation at col. 6, line 42- col. 8, line 3, particularly the paragraph spanning cols. 7 and 8, reveals that the same conductor(s) used to transmit the 40 kHz signal are also used instantaneously thereafter to detect any return signal of the stylus. Nothing in Greanias discloses or suggests that the WIRE SELECT MUX 74 of Fig. 6, changes wire connections between the transmission mode and the instantaneously following detection mode. Accordingly, in Greanias, an RF signal is not input into one or more “column” conductors of the array while coupled RF signals are output from the “row” conductors in a predetermined order as directed by first and second control signals from the control circuit as is required by claim 2. Again, changing the way Greanias works to correspond to the claim language would change the principle of operation of the Greanias stylus and location system.

**The Rejection of Claim 10 Depending From Claim 2 Is Further Unsupported For the Following Additional Reason**

Claim 10 calls for the RF signal to have a frequency of approximately 100 kHz where the RF signal is the signal originally input into each column conductor. Greanias talks only about transmitting a 40kHz signal from the conductor array for position detection and transmitting data from the stylus on a frequency shift keying signal in the range of 100-300 kHz as a response. Using 100kHz as the input signal is contrary to the express teaching of the primary reference and the Examiner can cite no teaching or suggestion in the prior art to do so.

**The Rejections of Dependent Claims 7 and 11 Are Still Further Unsupported For the Following Additional Reason**

The rejections of these claims, calling for sine waves and 18 volt AC signals, respectively, are not based upon prior art but rather upon the characterization of merely being “old” and “well know” and “an arbitrary design choice”. There is nothing in the prior art that indicates or even suggests these values are suitable let alone desirable from all other possible design choices for the Greanias system.

Another requirement for a *prima facie* case of obviousness is that there must be a reasonable expectation of success and that expectation must be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 9478 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2142. There is nothing in the relied upon prior art that provides such an expectation of success with Greanias using either sine waves or an 18 AC signal.

**The Rejections of Independent Claim 14 and Claims 15-16 Depending Therefrom Are Still Further Unsupported For the Following Additional Reason**

Independent claim 14 is directed to the method of using an interactive book system responsive to the presence of a human finger that sets forth the step of “(a) detecting the human finger as the finger enters an RF field generated by the reading system....” The Greanias system does not operate that way and to modify it to do so would impermissibly change its principle of operation.

**New Claims 18-27**

New claims 18-27 are presented for examination. Claims 18-22 depend directly or indirectly from original claim 1. New claims 23-27 depend directly or indirectly from original claim 14. Support for the claims can be found in paragraphs [0035]-[0036] and [0057]-[0059]. No new matter is being added.

**Conclusion**

For the foregoing reasons, reconsideration to withdraw of all the rejections of claims 1-17, examination of new claims 18-27 and allowance of the application and all currently pending claims are respectfully requested.

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Respectfully submitted,

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